



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,985	11/26/2001	Brian N. Benschoter	61575-1005	2859

Alex L. Yip
Kaye Scholer LLP
425 Park Avenue
New York, NY 10022

7590

12/19/2008

EXAMINER

BATURAY, ALICIA

ART UNIT	PAPER NUMBER
----------	--------------

2446

MAIL DATE	DELIVERY MODE
-----------	---------------

12/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/994,985	Applicant(s) BENSCHOTER ET AL.	
	Examiner Alicia Baturay	Art Unit 2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,10,12-29,32-41,46-50,52-66 and 68-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10, 12-29, 32-41, 46-50, 52-66 and 68-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the amendment filed 11 September 2008.
2. Claim 65 was amended.
3. Claims 6-8, 11, 30, 31, 42-45, 51 and 67 were cancelled.
4. Claims 1-5, 9, 10, 12-29, 32-41, 46-50, 52-66 and 68-80 are pending in this Office Action.

Response to Amendment

5. The rejection is respectfully maintained as set forth in the last Office Action mailed on 11 September 2008. Applicant's arguments with respect to claims 1-5, 9, 10, 12-29, 32-41, 46-50, 52-64, 66 and 68-80 have been fully considered but they are not persuasive and the old rejection maintained.
6. ***Applicant Argues:*** Robbin discloses a first pane containing an index of media files selected from a database, and "second" and "third" panes that display information related to the media files in the first pane. Neither the "second pane" nor the "third pane" displays "second indicators" representing media files selected by the user from those shown in the first pane, as required by claim 1.

In Response: The examiner respectfully submits that Robbin teaches displaying in a second region (Robbin, Fig. 1, element 26) of the display device different from the first region (Robbin, Fig. 1, element 50), second indicators (an index 24 of a plurality of media

icons) representing the respective information segments selected by the user from among the information segments represented by the displayed first indicators (First selected information 28 is an index of a plurality of artists associated with each of the media files – see Robbin, Fig. 1, element 24; col. 2, lines 15-16 and 20-25); allowing the user to play any one of the respective information segments represented by a corresponding second indicator in the second region (Robbin, Fig. 10, element 24; col. 4, lines 45-63). This renders the rejection proper, and thus the rejection stands.

7. ***Applicant Argues:*** Robbin does not disclose a “third region” that displays media files “selected by the user from the playlist, and therefore fails to teach or suggest a “third region” that displays “third indicators” selected from the claimed “second region,” as required by claim 1.

In Response: The examiner respectfully submits that the Katinsky reference was used to teach the third region, not the Robbin reference. Katinsky teaches allowing the user to rearrange the sequence of the third indicators displayed in the third region to affect an order in which the user selected information segments (the user can modify the play list to arrange the media objects into a desired playing order – see Katinsky, Fig. 4; col. 5, lines 17-27) are to be presented to the user (the object player is used to play the currently selected media object from the play list in the sequencer – see Katinsky, Fig. 1, element 16 and Fig. 7; col. 6, lines 1-26). This renders the rejection proper, and thus the rejection stands.

8. ***Applicant Argues:*** Smith does not teach or suggest the additional category “link” connects to, and therefore represents, a “default category page” (a favorites page). It is not the claimed “fourth indicator,” which is displayed on the claimed “second page” and which is “selected by the user from among the second and third indicators in the list,” as claimed in claim 32.

In Response: The examiner respectfully submits that the Smith reference is not used to teach the fourth indicator. However, Smith teaches receiving from a user a request to perform a search and one or more search terms (the user is able to directly enter a “search query” in query entry – see Smith, Fig. 4, element 440; col. 9, lines 1-8); searching a database in response to the request (data includes databases – see Smith, col. 8, lines 60-67); displaying, in a first region of a first page of a display device, a plurality of first indicators each representative of a respective one of a plurality of information segments retrieved from the database that includes at least one of the one or more search terms (If a clear pattern of using an Internet browser to search for news articles were indicated by an analysis of user preferences and habits, a link to default category page links 451 containing the users favorite news locations could be displayed – see Smith, Fig. 4, element 450; col. 8, lines 35-59 and col. 10, lines 41-47). This renders the rejection proper, and thus the rejection stands.

9. ***Applicant Argues:*** Neither Katinsky nor Robbin teaches or suggests “displaying, on a second page shown on the display device, one or more additional first indicators each

representative of a respective one of the plurality of information segments, the one or more additional first indicators being available only on the second page,” as required by claim 80.

In Response: The examiner respectfully submits that the claim language in claim 80 does not explicitly state that the second page must be outside of the media icon access panel. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). See MPEP § 2106.

The examiner respectfully submits that Katinsky teaches displaying, on a second page shown on the display device (Katinsky, Fig. 2A, element 22), one or more additional first

indicators each representative of a respective one of the plurality of information segments, the one or more additional first indicators being available only on the second page (to begin browsing the content of the site, the user selects one of the subject matter tabs [which] causes the top level of an outline to appear as a bulleted list containing bulleted items. At the lowest level of the outline is a list of media icons which represent a media object. Each media icon includes a graphic icon indicating the media type – see Katinsky, col. 4, lines 26-56). This renders the rejection proper, and thus the rejection stands.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 9, 10, 12-15, 19, 61, 62 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky et al. (U.S. 6,452,609) in view of Robbin (U.S. 6,731,312).
12. Only those claims that have been amended by Applicant or required a change in the grounds of rejection are formally addressed in this action. For those claims not formally addressed, the rejections have not been altered from what was set forth in previous actions. Therefore, the substance of these rejections for claims not formally addressed in this action can be found in prior Office Actions, see the Office Action dated 09 June 2008.

13. Claims 4, 5 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Robbin and further in view of Ahmad et al. (U.S. 6,263,507).
14. Claims 20-22, 25-29, 46-48, 52-56, 60, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Girouard et al. (U.S. 7,222,163) and further in view of Robbin.
15. Claims 47, 48 and 52-54 do not teach or define any new limitations above claims 21, 22 and 26-28 and therefore are rejected for similar reasons.
16. Claims 23, 24, 49, 50 and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Girouard in view of Robbin and further view of Ahmad.
17. Claims 32-41, 66 and 75-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Smith (U.S. 6, 615,248) and further in view of Robbin.
18. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Robbin and further in view of Munger (“iBasics: iTunes, Part 1 - Encode, Organize, Radio and Play”).

19. With respect to claim 65, Katinsky teaches a method for presenting to a user media segments in an order selected by the user, the method comprising: displaying, in a first region of a first page shown on a display device, a plurality of first indicators each representative of a respective one of a plurality of information segments selected from a database during a search of the database (Katinsky, Fig. 1, element 12 and Fig. 2C, element 32; col. 4, lines 26-56); receiving from the user selections of individual information segments from among the plurality of information segments represented by the displayed first indicators, each of the user selected information segments being represented by respective second indicators, the second indicators being different from the corresponding information segments and first indicators (Katinsky, col. 4, lines 60-65); displaying simultaneously with at least one of the plurality of first indicators, in a second region of the first page different from the first region, a list comprising the second indicators corresponding to the user selected information segments, in response to the selection of each individual information segment, the second indicators being displayed in a sequence within the list corresponding to an order in which the information segments are selected (Katinsky, Fig. 1, element 14 and Fig. 4; col. 4, line 66 – col. 5, line 27); displaying the list including the selected second indicators on the second page simultaneously with the one or more additional first indicators (Katinsky, Fig. 1, element 12 and Fig. 2C, element 32; col. 4, lines 26-56); allowing the user to select at least one additional information segment represented by the one or more additional first indicators (Katinsky, col. 8, lines 21 – col. 9, line 11); displaying, within the list, at least one additional second indicator corresponding to the at least one selected additional information segment, the at least one additional second indicator being displayed in the sequence in a position

corresponding to an order in which the at least one additional information segment is selected with respect to the selected information segments (Katinsky, Figs. 6A and 6B; col. 5, lines 35-54); allowing the user to select an indicator from among the second indicators and the at least one additional second indicator in the list and change the position of the selected indicator with respect to the other second indicators and additional second indicators in the sequence (Katinsky, Fig. 4; col. 5, lines 17-27); and presenting the user selected information segments represented by the respective second indicators and additional second indicators in the sequence in the same order as the respective second indicators and additional second indicators in the sequence (Katinsky, Fig. 1, element 16 and Fig. 7; col. 6, lines 1-26).

Katinsky does not explicitly teach displaying one or more first indicators in response to a selection by the user to displaying additional first indicators.

However, Robbin teaches displaying, on a second page shown on the display device (Robbin, Fig. 3, elements 58 and 60; col. 3, lines 5-10), in response to a selection by the user of an option, displayed on the first page, to display additional first indicators (Robbin, Fig. 3, element 40b; col. 3, lines 20-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Katinsky in view of Robbin in order to enable displaying one or more first indicators in response to a selection by the user to displaying additional first indicators. One would be motivated to do so in order to enable a media player that includes an index of media files generated by reading the entries of one or more directories.

The combination of Katinsky and Robbin does not explicitly teach one or more additional first indicators each representative of a respective one of the plurality of information segments selected from the database during the search.

However, Munger teaches one or more additional first indicators each representative of a respective one of the plurality of information segments selected from the database during the search (Munger, page 4, "Radio").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Katinsky and Robbin in view of Munger in order to enable displaying one or more additional first indicators each representative of a respective one of the plurality of information segments selected from the database during the search. One would be motivated to do so in order to enable a media player that includes an online radio service that offers lots of different types of music.

20. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robbin in view of Katinsky.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2446

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
December 18, 2008

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2446